

Application No. 10/098,683
Amendment dated December 18, 2006
Reply to Office Action of June 22, 2006

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REMARKS

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Applicant amended claims 54 and 79 to further define Applicant's claimed invention.

In the Office Action, the Examiner rejected claims 54-90 and 92-103 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-84 of U.S. Patent No. 6,758,849; and rejected claims 54-90 and 92-103 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-84 of U.S. Patent No. 6,364,880. Applicant will submit a Terminal Disclaimer to the extent necessary to overcome the obviousness-type double patenting rejections corresponding to the language included in the claims ultimately deemed allowable by the Examiner over the prior art.

The Examiner rejected claims 54-90 and 92-103 under 35 U.S. § 103(a) as being unpatentable over U.S. Patent No. 5,026,373 to Ray et al. ("Ray"). According to the Examiner, "it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the bone growth promoting materials as claimed in" the implant of Ray "in order to promote new bone growth." Furthermore, the Examiner indicates that it "would have been [an] obvious matter of design choice to employ more than one bone growth promoting material" in Ray.

According to MPEP § 2142, to establish a prima facie case of obviousness under 35 U.S.C. § 103(a), the following three (3) basic criteria must be met:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Furthermore, the teaching or suggestion to make the claimed combination must be found in the prior art, and not based on Applicant's disclosure. In other words, a prima facie case of obviousness cannot be based on hindsight employed after a contemplation of Applicant's disclosure. According to MPEP § 2142, "impermissible

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hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art."

Regarding the rejection under 35 U.S.C. § 103(a), the Examiner has not provided any teaching or suggestion indicating why it would have been an obvious matter of design choice to employ more than one bone growth promoting material in Ray. More specifically, the Examiner has failed to show any teaching or suggestion regarding the combination of "bone morphogenetic protein in at least a portion of said hollow interior to promote bone growth from adjacent vertebral body to adjacent vertebral body through said implant" and "a fusion promoting material other than bone and other than bone morphogenetic protein, said fusion promoting material being in at least a portion of said hollow interior to promote bone growth from adjacent vertebral body to adjacent vertebral body through said implant" as recited in independent claims 54 and 79. As such, it appears that the Examiner has improperly applied hindsight in constructing the combination forming the basis of the rejection under 35 U.S.C. § 103(a).

Because the Examiner has relied on hindsight to construct the combination forming the basis of the rejection under 35 U.S.C. § 103(a), the Examiner has not made a showing of a prima facie case of obviousness. Therefore, the rejection under 35 U.S.C. § 103(a) is deemed to be overcome. Consequently, Applicant submits that independent claims 54 and 79 are patentable and that dependent claims 55-65, 67-78, 80-90, and 92-103 dependent from one of independent claims 54 and 79, or claims dependent therefrom, are patentable at least due to their dependency from an allowable independent claim.

In view of the foregoing remarks, it is respectfully submitted that the claims, as amended, are patentable. Therefore, it is requested that the Examiner reconsider the outstanding rejections in view of the preceding comments.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any

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fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-3726.

Respectfully submitted,

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Dated: December 18, 2006

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